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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,534	06/25/2003	Alexandre Bronstein	BRONSTEIN.001	4130

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EXAMINER
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KHAN, SUHAIL

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/603,534

Applicant(s)

BRONSTEIN, ALEXANDRE

Examiner

Suhail Khan

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 9, 21-24, 26-29 and 31 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6650742 to Elliott et al.

Referring to claim 1, Elliott et al disclose a method for defense against an unwanted communication (col 1, lines 52-55, penalizing service, annoying voice call), comprising: identifying a communication channel to beneficiary of the unwanted communication (col 1, lines 56-60, identifies a caller); striking back against the beneficiary by sending a communication via the communication channel to the beneficiary (col 1, lines 60-65, charge the caller; it is inherent that by charging the caller, communication is being sent).

Referring to claim 2, Elliott et al disclose the method of claim 1, wherein sending a communication via the communication channel to the beneficiary comprises sending a communication via the communication channel that includes a request that the beneficiary cease further unwanted communications to a recipient of the unwanted communication (col 1, lines 52-55, penalizing service, it is inherent that the penalizing service is an indication that the recipient is asking the sender to cease further unwanted communication).

Referring to claim 3, Elliott et al disclose the method of claim 1, wherein sending a communication via the communication channel to the beneficiary comprises repeatedly sending the communication in accordance with a set of strike back parameters (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen; col 1, lines 60-65, charge the caller; it is inherent that by charging the caller, communication is being sent).

Referring to claim 4, Elliott et al disclose the method of claim 3, further comprising adjusting a cost imposed on the beneficiary with the communication by adjusting the strike back parameters (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 5, Elliott et al disclose the method of claim 1, wherein identifying comprises identifying a money input channel used by the beneficiary to obtain a benefit (col 1, lines 56-60, identifies a caller; col 1, lines 60-65, charge the caller).

Referring to claim 6, Elliott et al disclose the method of claim 1, wherein identifying comprises calling a phone number contained in the unwanted communication (col 4, lines 11-13, directory number corresponding to a voice call).

Referring to claim 9, Elliott et al disclose the method of claim 1, wherein identifying comprises performing a pattern match on a text of the unwanted communication (col 3, lines 10-14, predetermined set of conditions).

Referring to claim 21, Elliott et al disclose a defense coordinator (col 1, lines 52-55, penalizing service) that obtains an identify request from a recipient of an unwanted communication and that in response identifies a communication channel to a beneficiary of the unwanted communication (col 1, lines 56-60, identifies a caller) and that performs a strike back against the beneficiary by sending a communication via the communication channel to the

beneficiary (col 1, lines 60-65, charge the caller; it is inherent that by charging the caller, communication is being sent).

Referring to claim 22, Elliott et al disclose the defense coordinator (col 1, lines 52-55, penalizing service) of claim 21, wherein the communication includes a request that the beneficiary cease further unwanted communications to the recipient (col 1, lines 52-55, penalizing service, it is inherent that the penalizing service is an indication that the recipient is asking the sender to cease further unwanted communication).

Referring to claim 23, Elliott et al disclose the defense coordinator (col 1, lines 52-55, penalizing service) of claim 21, wherein the communication channel is a money input channel used by the beneficiary to obtain a benefit (col 1, lines 56-60, identifies a caller; col 1, lines 60-65, charge the caller).

Referring to claim 24, Elliott et al disclose the defense coordinator (col 1, lines 52-55, penalizing service) of claim 21, wherein the defense coordinator maintains a set of information pertaining to the beneficiary and determines a set of strike back parameters in response to the information and repeatedly performs the strike back in accordance with the strike back parameters (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 26, Elliott et al disclose a distributed strike back system comprising: recipient system of an unwanted communication (col 1, lines 52-55, penalizing service, annoying voice call); defense coordinator that obtains an identify request from the recipient system and that in response determines a set of strike back parameters that identify a communication channel a beneficiary of the unwanted communication and that sends the strike back parameters to the recipient system such that the recipient system performs a strike back against the beneficiary by

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sending a communication via the communication channel to the beneficiary (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 27, Elliott et al disclose the distributed strike back system (col 1, lines 52-55, penalizing service) of claim 26, wherein the communication includes a request that the beneficiary cease further unwanted communications to the recipient system (col 1, lines 52-55, penalizing service, it is inherent that the penalizing service is an indication that the recipient is asking the sender to cease further unwanted communication).

Referring to claim 28, Elliott et al disclose the distributed strike back system (col 1, lines 52-55, penalizing service) of claim 26, wherein the communication channel is a money input channel used by the beneficiary to obtain a benefit (col 1, lines 56-60, identifies a caller; col 1, lines 60-65, charge the caller).

Referring to claim 29, Elliott et al disclose the distributed strike back system (col 1, lines 52-55, penalizing service) of claim 26, wherein the defense coordinator maintains a set of information pertaining to the beneficiary and determines the strike back parameters in response to the information such that the strike back parameters specify an intensity of the strike back against the beneficiary (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 31, Elliott et al disclose the distributed strike back system (col 1, lines 52-55, penalizing service) of claim 26, wherein defense coordinator identifies the communication channel by performing a pattern match on a text of the unwanted communication (col 3, lines 10-14, predetermined set of conditions).

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-8, 25 and 30 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6650742 to Elliot et al, in view of U.S. Patent App. No. 2002/0004800 to Kikuta et al.

Referring to claim 7, Elliot et al disclose the identifying method of claim 1 (col 1, lines 56-60, identifies a caller). Elliot et al do not disclose that the method comprises accessing a website specified in the unwanted communication. However, Kikuta et al show website browsing (page 7, paragraph 109, browse a web site). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show identifying comprises accessing a website specified in the unwanted communication, as taught by Kikuta et al, the motivation being directing the bill to the appropriate caller (Elliot et al, col 1, lines 61-65).

Referring to claim 8, Elliot et al disclose the identifying method of claim 7 (col 1, lines 56-60, identifies a caller). Elliot et al do not disclose the method comprises exploring a web site specified in the unwanted communication to find a web page that is financially important to the beneficiary. However, Kikuta et al show website browsing (page 7, paragraph 109, browse a web site; it is also inherent that the website related to the unwanted communication will itself be or will contain information regarding the parent website which would be financially responsible). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show identifying comprises exploring a web site specified in



the unwanted communication to find a web page that is financially important to the beneficiary, as taught by Kikuta et al, the motivation being directing the bill to the appropriate caller (Elliot et al, col 1, lines 61-65).

Referring to claims 25 and 30, Elliott et al disclose the defense coordinator (col 1, lines 52-55, penalizing service) of claim 24. Elliot et al do not disclose that the defense coordinator generates a web page that enables the beneficiary to stop the strike back. However, Kikuta et al show website browsing and requesting a key ID (page 7, paragraph 109, browse a web site). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show that the defense coordinator generates a web page that enables the beneficiary to stop the strikeback, as taught by Kikuta et al, the motivation being directing the bill to the appropriate caller (Elliot et al, col 1, lines 61-65)

5. Applicant's arguments filed 3/25/2005 have been fully considered but they are not persuasive.

Referring to claims 1-9 and 21-31, Applicant argues that Elliot et al do not disclose sending a communication via the communication channel to the beneficiary. Examiner respectfully disagrees.

Elliot et al disclose striking back against the beneficiary by sending a communication via the communication channel to the beneficiary (col 1, lines 60-65, charge the caller; it is inherent that by charging the caller, communication is being sent)

Regarding the combination of the Elliot et al and the Kikuta et al references for claims 7 and 8, Applicant questions the obviousness. Examiner maintains that Elliot et al discloses all the



limitations for claims 7 and 8 except the 'website' part and Kikuta et al shows that feature, hence holding valid grounds for rejection.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suhail Khan whose telephone number is (571) 272-7910. The examiner can normally be reached on M-F from 7:30 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (571) 272-7905. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sk

W. R. YOUNG  
PRIMARY EXAMINER